

Attorney Docket No. P63943US0
Serial No. 09/417,135

Remarks/Arguments:

Claims 66-80, as presented in the Amendment filed September 16, 2003, are pending.

The pending claims are presented hereby, again, in compliance with the Office Action mailed October 24, 2003 (the "instant Office Action"). As required, by the instant Office Action, claim 68 as presented hereby recites "(currently amended)".

Applicants wish to thank the examiner for kindly providing the period of time for response set in the instant Office Action.

For the record, correction is necessary with respect to items mentioned in the instant Office Action. No paper was submitted "under 37 CFR 1.129(a)," nor was any paper "filed on September 26, 2003," as set forth in the instant Office Action (page 2, first paragraph). Apparently, the instant Office Action refers to the aforesaid "Amendment filed September 16, 2003."

The remarks/arguments set forth in the Amendment filed September 16, 2003 are repeated as follows.

By the instant amendment claim 68 is revised to correct a clerical error, i.e., by changing "a-terpenyl" to read " α -terpenyl."

Also by the instant amendment, claims 51-65 are canceled, without prejudice or disclaimer.

In accordance with the final Office action claims 51-80 were rejected under 35 USC 102(a) as being allegedly anticipated by WO98/07772 (Miura) or, alternatively, under 35 USC 103(a) for alleged obviousness based on Miura. Reconsideration is requested.

Attorney Docket No. P63943US0
Serial No. 09/417,135

As applied against claims 51-65, the rejections of record are rendered moot by cancellation, hereby, of the rejected claims.

As applied against claims 66-80, it is applicants' understanding that the rejections of record are, now, apparently considered overcome by the examiner, in view of discussions held between the examiner and applicants' representative during a telephone interview on 5 August 2003. The Statement of the Substance of the Interview is set forth below.

In that the rejections of record as applied against claims 51-65 are rendered moot by these claims having been cancelled, and in that the rejections of record as applied against claims 66-80 have been overcome, as explained below, withdrawal of the rejections of record appears to be in order.

Statement of the Substance of the Interview

On August 5, 2003, applicants' representative conducted a telephone interview with Examiner Julian Mercado, Art Unit 1745, of the PTO.

The art discussed during the interview consisted of WO98/07772 (Miura '772), which contains a disclosure equivalent to that of U.S. 6,162,563 (Miura '563). All rejections of record were discussed; but, primarily, the rejections under section 102(a) and section 103(a) based on Miura '772. Independent claims 51 and 66 were discussed in detail during the interview; however, the discussion concerned all pending claims 51-80.

The interview explored the reasons for the examiner maintaining the rejections based on Miura '772, considering that (1) the presently claimed invention uses *propylene oxide* as one of the

Attorney Docket No. P63943US0
Serial No. 09/417,135

monomers (reactants), whereas Miura '772 does not and, as a result, (2) the polyether copolymer of the presently claimed invention (as shown in claim 66) contains an *oxypropylene repeating unit in the polymer backbone*, whereas the polyether copolymer of Miura '772 does not contain an oxypropylene repeating unit in the polymer backbone (although it does contain such a repeating unit in a side chain of the polymer).

Applicants' representative, first, referred the Examiner to the comparison between the presently claimed invention and Miura '777 illustrated in Appendix I attached to the amendment filed August 9, 2002, in the PTO. Comparison between the respective polymers as illustrated shows an oxypropylene repeating unit, i.e., $(-\text{CH}_2-\text{CH}(\text{CH}_3)-\text{O}-)_n$; whereas, the prior art Miura polymer does not contain an oxypropylene unit in the backbone, albeit it does contain such a unit in a side chain, i.e., $-\text{CH}_2-\text{O}-(-\text{CH}_2-\text{CH}_2-\text{O})_n-\text{R}^1$, when $N=1$ and $\text{R}^1=\text{methyl } (-\text{CH}_3)$, the structural formula (I') disclosed in Miura '772 (at col. 2, lines 55-60, of Miura '563). This repeating unit of formula (I') is derived from the monomer of formula (I) (Miura '563, col. 1, lines 55-60) of Miura '772. This starting material in Miura '772 is readily distinguishable from the propylene oxide starting material (monomer) of the presently claimed invention, i.e., whereas the presently claimed starting material consists of a methyl group attached to oxirane (epoxy) ring, the Miura starting material for formula (I) consists of an oxirane ring attached, not to a methyl $(-\text{CH}_3)$ group but a substituted methyl group, the substituent being $-\text{O}-(-\text{CH}_2-\text{CH}_2-\text{CH}_2-\text{O})_n-\text{R}^1$.

As argued in the previously filed amendment, the polymer units in your identified as formulas (II'), (III'-1) and (III'-2) apparently correspond to the repeating units of the present invention (as

Attorney Docket No. P63943US0
Serial No. 09/417,135

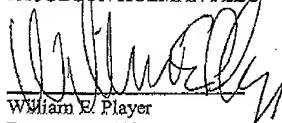
recited in claim 66) identified as formulas (II), (III'-1), and (III'-2), respectively. However, as explained above, there is no repeating unit in the Miura polymer that corresponds to oxypropylene of the formula (I-), as recited in present claim 66; and, correspondingly, Miura neither teaches nor suggests the "repeating unit derived from propylene oxide in the polymer backbone," i.e., recited in subparagraph A of claim 51.

As acknowledged in the Examiner's Interview Summary, the examiner finds claims 66-80 apparently patentable over the applied prior art. The examiner did not find the remaining active claims (claims 51-65) patentable.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC



By

William E. Player
Reg. No. 31,409

400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004

Tel: (202) 638-6666

Fax (202) 393-5350

Date: November 24, 2003

WEP/bap

R:\Home\JTH\HOLMAN\2003\September\03943 repl and.wpd